

REMARKS

In the non-final Office Action, the Examiner rejects claim 41 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention; rejects claims 1, 2, 8, 10, 13-17, 20, 21, 41 and 47 under 35 U.S.C. § 103(a) as being unpatentable over MAO (U.S. Patent No. 6,546,385) in view of non-patent literature document entitled "How to Interpret your Search Results" (GOOGLE1), and further in view of MITCHELL (U.S. Patent No. 5,963,966); rejects claims 3, 11, 12, 48 and 49 under 35 U.S.C. § 103(a) as being unpatentable over MAO in view of GOOGLE1, in view of MITCHELL, and further in view of BAXTER et al.(U.S. Patent Application Publication No. 2003/0229637); rejects claims 5-7 and 9 under 35 U.S.C. § 103(a) as being unpatentable over MAO in view of GOOGLE1, in view of MITCHELL, and further in view of SMITH (U.S. Patent No. 6,502,076); rejects claim 18 under 35 U.S.C. § 103(a) as being unpatentable over MAO in view of GOOGLE1, in view of MITCHELL, and further in view of CRAGUN et al. (U.S. Patent No. 5,832,212); rejects claim 19 under 35 U.S.C. § 103(a) as being unpatentable over MAO in view of GOOGLE1, in view of MITCHELL, and further in view of non-patent literature document entitled "Google Search Technology" (GOOGLE2).; rejects claims 22, 23, 31, 34-38 and 42 under 35 U.S.C. § 103(a) as being unpatentable over MAO in view of MITCHELL; rejects claims 26-28 and 30 under 35 U.S.C. § 103(a) as being unpatentable over MAO in view of MITCHELL, and further in view of SMITH; rejects claims 24, 32 and 33 under 35 U.S.C. § 103(a) as being unpatentable over MAO in view of MITCHELL, and further in view of BAXTER et al.; rejects claim 39 under 35 U.S.C. §

103(a) as being unpatentable over MAO in view of MITCHELL, and further in view of CRAGUN et al.; rejects claim 40 under 35 U.S.C. § 103(a) as being unpatentable over MAO in view of MITCHELL, and further in view of GOOGLE2; and rejects claim 43 under 35 U.S.C. § 103(a) as being unpatentable over MAO in view of MITCHELL, in view of BAXTER et al., and further in view of SMITH. Applicant respectfully traverses these rejections.

By way of this Amendment, claims 1, 21, 22, 43, and 47 have been amended to improve form and claim 41 has been canceled without prejudice or disclaimer. Claims 1-3, 5-24, 26-28, 30-40, 42, 43, and 47-49 are now pending in the present application. Reconsideration and allowance of all claims in view of the following remarks are respectfully requested.

Rejections Under 35 U.S.C. § 112, second paragraph

Claim 41 stands rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. By way of the present amendment, claim 41 has been canceled without prejudice or disclaimer. Withdrawal of the pending rejection under 35 U.S.C. § 112, second paragraph is respectfully requested.

Rejections Under 35 U.S.C. § 103(a)

Claims 1, 2, 8, 10, 13-17, 20, 21, and 47 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over MAO in view of GOOGLE1, and further in view of MITCHELL. Applicant respectfully traverses this rejection.

A proper rejection under 35 U.S.C. § 103 requires that three basic criteria be met. First, there must be some suggestion or motivation, either in the references themselves, or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest each and every claim limitation. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not the applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). The cited combination of MAO, GOOGLE1, and MITCHELL do not disclose or reasonably suggest the combination of features recited in Applicant's claims 1, 2, 8, 10, 13-17, 20, 21, and 47.

For example, independent claim 1 recites a computer-implemented method including storing in a searchable database data sets representing printed items from publications respectively printed by a plurality of respective publishers, each data set including text from at least one of the printed items, wherein storing data sets representing printed items includes storing data sets representing advertisements printed with the printed items; storing an index representing information included in a plurality of web documents; receiving a search query; searching the index for web documents, the search being based on-the search query; searching the data sets in the searchable database for data sets representing printed items, the search being based on the search query; generating an integrated ranked listing comprising at least one characterization of at least one of the relevant web documents and at least one characterization of at least one of the relevant printed items; and for said at least one of the relevant printed items, providing an

electronic reference for accessing further information. The cited combination of MAO, GOOGLE1, and MITCHELL do not disclose or reasonably suggest the combination of features recited in Applicant's claim 1.

For example, the combination of MAO, GOOGLE1, and MITCHELL does not disclose or suggest that storing data sets representing printed items includes storing data sets representing advertisements printed with the printed items, as recited in claim 1. In rejecting claim 1, the Examiner relies on col. 3, lines 50-58 and col. 4, lines 27-30 of MAO for allegedly disclosing this feature. (Office Action – pg. 4). Applicant respectfully disagrees with the Examiner's interpretation of MAO.

At col. 3, lines 50-58, MAO discloses:

However, alternatively, the document data 103 could be read into the index creation system 102 by a document reader 104, which is equipped with an OCR (Optical Character Recognition) engine for converting hardcopy documents to ASCII text. Once the document data, e.g., text and graphics, 103 is read by the index creation system 102, it is temporarily stored in a memory 108 to further process the document data 103 to create an index table therefrom.

This section of MAO discloses that a document reader may read a document into an index creation system, convert the document to ASCII text and store the data into a memory that is then used to create an index table. This section of MAO does not disclose or even remotely suggest that storing data sets representing printed items includes storing data sets representing advertisements printed with the printed items, as recited in claim 1. Rather, this section of MAO discloses converting all data on a document to ASCII code and storing the data. Clearly, converting and storing all data on a document does not disclose or suggest storing data sets representing advertisements printed with the printed items, as recited in claim 1.

At col. 4, lines 27-30, MAO discloses:

This web server 150 can provide an electronic version of the index tables 128, such as on a web page for a publisher of the hard copy document.

This section of MAO discloses that an electronic version of the index tables that may be used to search a hardcopy version of the document is provided on a web page. This section of MAO does not remotely disclose that storing data sets representing printed items includes storing data sets representing advertisements printed with the printed items, as recited in claim 1. Rather, this section of MAO merely discloses that an index table associated with a hardcopy document may be provided in electronic form via a web page. MAO is related to a system for facilitating searching of hardcopy documents by providing an index table associated with the document. (See, MAO Abstract). This index table may be provided as a 2D barcode printed with the hardcopy document or may be provided in electronic form. A search assistant may be used to search the index table for requested information. (Id.) The identified sections of MAO, or any section of MAO, do not disclose or even remotely suggest storing data sets representing advertisements printed with the printed items, as recited in claim 1.

For at least these reasons, claim 1 is patentable over the cited combination of MAO, GOOGLE1, and MITCHELL. Reconsideration and withdrawal of the pending rejection of claim 1 are respectfully requested.

Claims 2, 8, 10, 13-17, and 20 depend from claim 1 and are patentable over the cited combination of MAO, GOOGLE1, and MITCHELL for at least the reasons set forth above, with respect to claim 1. Moreover, these claims are patentable over MAO, GOOGLE1, and MITCHELL for reasons of their own.

For example, MAO, GOOGLE1, and MITCHELL do not disclose or suggest that returning at least one characterization of at least one of the relevant printed items includes returning information from a data set representing an advertisement for said at least one of the relevant printed items, as recited in claim 8. In rejecting claim 8, the Examiner relies on col. 9, lines 8-32 of MITCHELL for allegedly disclosing this feature. (Office Action – pg. 7). Applicant respectfully disagrees with the Examiner's interpretation of MITCHELL.

At col. 9, lines 8-32, MITCHELL discloses:

A search strategy may be implemented in the method as follows. When a search string is entered, the uncorrected OCR of the document pages is searched. The entire line of text containing the matching string is retrieved. Next, an HTML page is formatted to contain the page on which the string matched, as well as the full text line containing the string. Additionally, hyperlinks are established that allow the user to click on the page number and have the document page retrieved. FIG. 10 shows the shell program that is used to perform the search and display the results.

In the sample implementation, each document page was scanned and OCR'd using the OmniPage professional software package. No attempt was made to correct the OCR and just the text recognition for each page was retained. No graphics were saved. These text files served as the database for the search and retrieval algorithms.

The UNIX "grep" command was used to implement the search routine for the demonstration. "Grep" searches files for a pattern and prints all lines that contain that pattern. The results of the "grep" were sent to a formatting program which creates a hypertext page with the results. FIG. 11 shows the results of a search for the string "vector" in the prototype document. Clicking on either the highlighted "page 13" or "page 16" causes the respective pages to be retrieved for viewing.

This section of MITCHELL discloses that a document is scanned in and subjected to OCR. The uncorrected OCR is searched and, if a match is found, the entire line of text including the match is retrieved. A web page is then formed to include the line of text and a link to the document page on which the line was found. This section of

MITCHELL does not disclose or even remotely suggest returning information from a data set representing an advertisement for said at least one of the relevant printed items, as recited in claim 8. In fact, MITCHELL does not disclose advertisements whatsoever.

For at least this additional reason, claim 8 is patentable over the combination of MAO, GOOGLE1, and MITCHELL. Reconsideration and allowance of claim 8 are respectfully requested.

Independent claim 21 includes subject matter similar to, yet possibly different in scope than, claim 1. Accordingly, claim 21 is patentable over the cited combination of MAO, GOOGLE1, and MITCHELL for at least reasons similar to those set forth above with respect to claim 1. Reconsideration and withdrawal of the rejection of claim 21 are respectfully requested.

Independent claim 47 includes subject matter similar to, yet possibly different in scope than claims 1 and 21. Accordingly, claim 47 is patentable over the cited combination of MAO, GOOGLE1, and MITCHELL for at least reasons similar to those set forth above with respect to claims 1 and 21. Reconsideration and withdrawal of the rejection of claim 47 are respectfully requested.

Claims 3, 11, 12, 48 and 49 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over MAO in view of GOOGLE1, in view of MITCHELL, and further in view of BAXTER et al. Applicant respectfully traverses this rejection.

Claims 3, 11, and 12 depend from claim 1. The disclosure of BAXTER et al. does not remedy the deficiencies in the disclosures of MAO, GOOGLE1, and MITCHELL, for at least reasons similar to those set forth above with respect to claim 1. Accordingly, claims 3, 11, and 12 are patentable over the cited combination of MAO,

GOOGLE1, MITCHELL, and BAXTER et al. set forth above with respect to claim 1.

Reconsideration and withdrawal of the rejection of claims 3, 11, and 12 are respectfully requested.

Claims 48 and 49 depend from claim 47. The disclosure of BAXTER et al. does not remedy the deficiencies in the disclosures of MAO, GOOGLE1, and MITCHELL set forth above with respect to claim 47. Accordingly, claims 48 and 49 are patentable over the cited combination of MAO, GOOGLE1, MITCHELL, and BAXTER et al., for at least the reasons set forth above with respect to claim 47. Reconsideration and withdrawal of the rejection of claims 48 and 49 are respectfully requested.

Claims 5-7 and 9 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over MAO in view of GOOGLE1, in view of MITCHELL, and further in view of SMITH. Applicant respectfully traverses this rejection.

Claims 5-7 and 9 depend from claim 1. Applicant submits that the disclosure of SMITH does not remedy the deficiencies in the disclosures of MAO, GOOGLE1, and MITCHELL noted above with respect to claim 1. Accordingly, claims 5-7 and 9 are patentable over the cited combination of MAO, GOOGLE1, MITCHELL, and SMITH, for at least the reasons set forth above with respect to claim 1. Reconsideration and withdrawal of the rejection of claims 5-7 and 9 are respectfully requested.

Claim 18 has been rejected under 35 U.S.C. § 103(a) as being unpatentable over MAO in view of GOOGLE1, in view of MITCHELL, and further in view of CRAGUN et al. Applicant respectfully traverses this rejection.

Claim 18 depends from claim 1. The disclosure of CRAGUN et al. does not remedy the deficiencies in the disclosures of MAO, GOOGLE1, and MITCHELL noted

above with respect to claim 1. Accordingly, claim 18 is patentable over the cited combination of MAO, GOOGLE1, MITCHELL, and CRAGUN et al., for at least the reasons set forth above, with respect to claim 1. Reconsideration and withdrawal of the rejection of claim 18 are respectfully requested.

Claim 19 has been rejected under 35 U.S.C. § 103(a) as being unpatentable over MAO in view of GOOGLE1, in view of MITCHELL, and further in view of non-patent literature document entitled "Google Search Technology" (GOOGLE2). Applicant respectfully traverses this rejection.

Claim 19 depends from claim 1. The disclosure of GOOGLE2 et al. does not remedy the deficiencies in the disclosures of MAO, GOOGLE1, and MITCHELL noted above with respect to claim 1. Accordingly, claim 19 is patentable over the cited combination of MAO, GOOGLE1, MITCHELL, and GOOGLE2, for at least the reasons set forth above, with respect to claim 1. Reconsideration and withdrawal of the rejection of claim 19 are respectfully requested.

Claims 22, 23, 31, 34-38, and 42 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over MAO in view of MITCHELL. Applicant respectfully traverses this rejection.

Independent claim 22 recites a computer-implemented arrangement including a search engine and a searchable electronic database, the computer-implemented arrangement being adapted to respond to Internet-based search queries and including a memory bank and a first programmable computer node, the memory bank and the programmable computer node being adapted to store the searchable database as data sets representing printed items from publications respectively printed by a plurality of

respective publishers, each data set including text from at least one of the printed items and information representing an advertisement printed with the at least one of the printed items; and a second programmable computer node including the search engine, the second programmable computer node adapted to search for web pages, the search being based on a search query and to search the data sets in the electronic database for data sets, the search being based on the search query, thereby identifying relevant Internet web pages and relevant data sets corresponding to relevant printed items, and to return at least one characterization of at least one of the relevant web pages and at least one characterization of at least one of the relevant printed items and, for said at least one of the relevant printed items, to provide the information representing an advertisement for said at least one of the relevant printed items. The cited combination of MAO and MITCHELL do not disclose or reasonably suggest the combination of features recited in Applicant's claim 22.

For example, the combination of MAO and MITCHELL does not disclose or suggest the memory bank and the programmable computer node being adapted to store the searchable database as data sets representing printed items from publications respectively printed by a plurality of respective publishers, each data set including text from at least one of the printed items and information representing an advertisement printed with the at least one of the printed items, as recited in claim 22. In rejecting claim 22, the Examiner relies on col. 3, lines 55-58 of MAO for allegedly disclosing this feature. (Office Action – pg. 33). Applicant respectfully disagrees with the Examiner's interpretation of MAO.

Col. 3, lines 55-58 of MAO (reproduced above) discloses that a document reader may read a document into an index creation system, convert the document to ASCII text and store the data into a memory that is then used to create an index table. This section of MAO does not disclose or even remotely suggest each data set including text from at least one of the printed items and information representing an advertisement printed with the at least one of the printed items, as recited in claim 22. Rather, this section of MAO discloses converting all data on a document to ASCII code and storing the data in an index table. Clearly, converting and storing all data on a document does not disclose or suggest storing information representing an advertisement printed with the at least one of the printed items, as recited in claim 22.

For at least these reasons, claim 22 is patentable over the cited combination of MAO and MITCHELL. Reconsideration and withdrawal of the pending rejection of claim 22 are respectfully requested.

Claims 23, 31, 34-38, and 42 depend from claim 22. Accordingly, these claims are patentable over the cited combination of MAO and MITCHELL for at least the reasons set forth above with respect to claim 22. Reconsideration and withdrawal of the rejection of claims 23, 31, 34-38, and 42 are respectfully requested.

Claims 26-28 and 30 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over MAO in view of MITCHELL, and further in view of SMITH. Applicant respectfully traverses this rejection.

Claims 26-28 and 30 depend from claim 22. The disclosure of SMITH does not remedy the deficiencies in the disclosures of MAO and MITCHELL noted above with respect to claim 22. Accordingly, claims 26-28 and 30 are patentable over the cited

combination of MAO, MITCHELL, and SMITH for at least the reasons set forth above, with respect to claim 22. Reconsideration and withdrawal of the rejection of claims 26-28 and 30 are respectfully requested.

Claims 24, 32 and 33 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over MAO in view of MITCHELL, and further in view of BAXTER et al. Applicant respectfully traverses this rejection.

Claims 24, 32, and 33 depend from claim 22. The disclosure of BAXTER et al. does not remedy the deficiencies in the disclosures of MAO and MITCHELL noted above with respect to claim 22. Accordingly, claims 24, 32, and 33 are patentable over the cited combination of MAO, MITCHELL, and BAXTER et al. for at least the reasons set forth above, with respect to claim 22. Reconsideration and withdrawal of the rejection of claims 24, 32, and 33 are respectfully requested.

Claim 39 has been rejected under 35 U.S.C. § 103(a) as being unpatentable over MAO in view of MITCHELL, and further in view of CRAGUN et al. Applicant respectfully traverses this rejection.

Claim 39 depends from claim 22. The disclosure of CRAGUN et al. does not remedy the deficiencies in the disclosures of MAO and MITCHELL noted above with respect to claim 22. Accordingly, claim 39 is patentable over the cited combination of MAO, MITCHELL, and CRAGUN et al. for at least the reasons set forth above, with respect to claim 22. Reconsideration and withdrawal of the rejection of claim 39 are respectfully requested.

Claim 40 has been rejected under 35 U.S.C. § 103(a) as being unpatentable over MAO in view of MITCHELL, and further in view of GOOGLE2. Applicant respectfully traverses this rejection.

Claim 40 depends from claim 22. The disclosure of GOOGLE2 does not remedy the deficiencies in the disclosures of MAO and MITCHELL noted above with respect to claim 22. Accordingly, claim 40 is patentable over the cited combination of MAO, MITCHELL, and GOOGLE2 for at least the reasons set forth above, with respect to claim 22. Reconsideration and withdrawal of the rejection of claim 40 are respectfully requested.

Claim 43 has been rejected under 35 U.S.C. § 103(a) as being unpatentable over MAO in view of MITCHELL, in view of BAXTER et al., and further in view of SMITH. Applicant respectfully traverses this rejection.

Independent claim 43 recites an arrangement for maintaining an electronic database that is searchable via a search engine in response to Internet-based search queries. The arrangement includes means for storing in the searchable database data sets representing printed items from publications respectively printed by a plurality of respective publishers, each data set including text from at least one of the printed items, wherein the data sets representing printed items include advertisements related to the printed items, the advertisements including information for linking to information about a corresponding product; with each stored data set representing printed items from publications, means for recording whether the respective publisher has authorized display of the printed item; means, responsive to a search query and including the search engine, for searching for web pages, the search being based on the search query and searching the

data sets in the electronic database for data sets, the search being based on the search query, thereby identifying relevant Internet web pages and relevant data sets corresponding to relevant publication items; means for returning at least one characterization of at least one of the relevant web pages and at least one characterization of at least one of the relevant publication items and, for said at least one of the relevant publication items for which the respective publisher has authorized display, providing an electronic path for accessing a copyrighted version thereof, wherein the means for returning at least one characterization of the relevant publication items includes returning information from an advertisement for said at least one of the relevant printed items. The cited combination of MAO, MITCHELL, BAXTER et al., and SMITH does not disclose or suggest each and every feature of claim 43.

For example, the combination of MAO, MITCHELL, BAXTER et al., and SMITH does not disclose or reasonably suggest the data sets representing printed items include advertisements related to the printed items, the advertisements including information for linking to information about a corresponding product, and wherein the means for returning at least one characterization of the relevant publication items includes returning information from an advertisement for said at least one of the relevant printed items, as recited in claim 43. In rejecting claim 43, the Examiner relies on col. 3, lines 55-58 and MAO for allegedly disclosing storing data sets including advertisements (Office Action – pg. 39). Additionally, the Examiner acknowledges that MAO does not disclose the advertisements including information for linking to information about a corresponding product, and wherein the means for returning at least one characterization of the relevant publication items includes returning information from an advertisement

for said at least one of the relevant printed items and relies on col. 2, line 59 through col. 3, line 5 of SMITH and col. 9, lines 8-32 of MITCHELL for allegedly disclosing these features (Id.). Applicant respectfully disagrees with this interpretation of MAO, SMITH, and MITCHELL.

As described above in relation to Fig. 1, col. 3, lines 55-58 of MAO discloses that a document reader may read a document into an index creation system, convert the document to ASCII text and store the data into a memory that is then used to create an index table. This section of MAO does not disclose or even remotely suggest data sets representing printed items that include advertisements related to the printed items, as recited in claim 43. Rather, this section of MAO discloses converting all data on a document to ASCII code and storing the data in an index table. For this reason alone, claim 43 is patentable over the combination of MAO, MITCHELL, BAXTER et al., and SMITH.

Even assuming *arguendo* that the disclosure of MAO can be interpreted to include data sets representing printed items that include advertisements related to the printed items (a point that Applicant strenuously does not concede), the disclosure of SMITH does not disclose or suggest that the advertisements in the data sets representing printed items include information for linking to information about a corresponding product, as required by claim 43.

Cols. 2, line 59 through col. 3, line 5 of SMITH discloses:

The retailer can add, update, and delete information about advertisements in the retail self-service terminal database. Adding information about an advertisement consists of specifying: (1) a description of the advertisement; (2) a time value, in seconds, that defines how long the ad should appear; (3) a uniform resource locator (URL) defining the content that appears when a consumer interacts with

the ad that is displayed; (4) a weighting factor that is used to determine the number of successive times the ad should be displayed within an attract loop; (5) a URL defining the actual advertisement content; and (6) an advertisement media type (for example, GIF image, MPEG video, ASF streaming video, and so forth).

This section of SMITH discloses that advertisement information may be updated to include various elements, such as a description time of display, URL, media, etc. This section of SMITH does not disclose that the data sets representing printed items include advertisements related to the printed items, the advertisements including information for linking to information about a corresponding product, as required by claim 43. In fact, SMITH does not disclose advertisements associated with printed items at all. Rather, the advertisements of SMITH appear to be web-specific advertisements created for display to customers in a self-service retail environment. Absent some additional suggestion in SMITH, it is unclear how the web or server-based advertisements of SMITH disclose or suggest that the data sets representing printed items include advertisements related to the printed items, the advertisements including information for linking to information about a corresponding product, as required by claim 43.

Col. 9, lines 8-32 of MITCHELL (reproduced above) discloses that a document is scanned in and subjected to OCR. The uncorrected OCR is searched and, if a match is found, the entire line of text including the match is retrieved. A web page is then formed to include the line of text and a link to the document page on which the line was found. This section of MITCHELL does not disclose or even remotely suggest the means for returning at least one characterization of the relevant publication items includes returning information from an advertisement for said at least one of the relevant printed items, as recited in claim 43. In fact, MITCHELL does not disclose advertisements whatsoever.

For at least these reasons, claim 43 is patentable over the combination of MAO, MITCHELL, BAXTER et al., and SMITH. Reconsideration and withdrawal of the rejection of claim 43 are respectfully requested.

Conclusion

In view of the foregoing amendment and remarks, Applicant respectfully requests withdrawal of the outstanding rejections and the timely allowance of this application. In addition, in the event that the application is not believed to be in condition for allowance, the Examiner is invited to contact Applicant's representative at the number shown below to expedite prosecution of this application.

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account No. 50-1070 and please credit any excess fees to such deposit account.

Respectfully submitted,

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